In re the Application of   DeWitt et al

Application No. 09/904,471

Attorney Docket No. 0412-P02404US0

Filed: July 13, 2001

For: METHOD AND APPARATUS FOR
       PROCESSING OUTGOING BULK MAIL

Examiner: Cosimano, Edward R.

Group Art Unit: 3653

RESPONSE TO OFFICE ACTION

In an Official Action Dated July 13, 2003 the Examiner rejected the pending claims as obvious over numerous references. Applicants request that the Examiner reconsider the rejection in light of the following discussion.

Claims 1-8 and 10-18 were rejected as obvious over Uno '127 in light of Sansone '864, Didriksen '055 or Thiel '214. The Examiner recognizes that Uno '127 does not teach a labeler as recited in the claims, however, the Examiner contends that it would be obvious to incorporate a labeler into Uno '127 based on Sansone '864, Didriksen '055 or Thiel '214.

The first problem with this proposed combination is that there is no

teaching or suggestion to combine Uno '127 with a labeler. In fact, it would be completely contrary to the operation of Uno to incorporate a labeler into the device disclosed in Uno. Accordingly, the combination proposed by the Examiner is not appropriate.

Uno '127 is directed to a device for use by a postal service, such as the U.S. Postal Service for scanning documents to identify the postage on a piece of mail, determine if it is the proper postage and then canceling the postage. The Examiner has not provided any evidence from the references that shows why one would be motivated to add a labeler to Uno. What would the purpose be? In other words, since the Uno device is directed to canceling postage why would someone think to alter the device by adding a labeler? The answer is that there is no such suggestion, and there would be no such motivation. It is not enough to say that both machines process mail. There must be some motivation to make the combination suggested by the Examiner, and that motivation must come from the references. Otherwise, the Examiner is improperly using Applicants' invention as a road map to pick and choose elements from the prior art. Accordingly, since there is no evidence of motivation to make the proposed combination, Applicants request that the Examiner reconsider the combination of Uno and Sansone '864, Didriksen '055 or Thiel '214.

Further, Uno does no teach or suggest other features of the pending claims, and the Examiner has not even addressed many of the features. For instance, Uno does not teach the feature of obtaining image data for the mail to determine the recipients of the pieces, as recited in claim 1. Further, since Uno is directed to a machine for processing mail that has already been stamped, Uno does not teach or suggest a printer operable to print the determined postage onto a label for a piece, as recited in claim 1.

Further, Uno does not teach or suggest features recited in the dependent

claims. For instance, Uno does not determine the postage in response to the determined recipient's address and the weight of the piece, as recited in claim 2. Uno does not teach the use of OCR to determine the recipient's address, as recited in claim 5. Uno does not teach or suggest a reject bin for receiving pieces for which the recipient's address is not determined, as recited in claim 8. Uno does not teach or suggest a roller bed transport as recited in claim 10. Uno doe not teach or suggest a verifier operable to scan the pieces and determine whether the postage was properly applied, as recited in claims 11 and 12. In light of the significant shortcomings between Uno and the claims, claims 1-18 are patentably distinct from Uno. Accordingly, Applicants request that the Examiner reconsider the rejection of the claims over Uno.

The Examiner also rejected claims 1, 2, 6-8, 10, 11 and 13-18 as obvious over any one of four primary references in combination with any one of the three secondary references recited above, namely Sansone '864, Didriksen '055 or Thiel '214. However, as discussed below, there are numerous features in the claims that are neither taught nor suggested by the references.

The first primary reference relied upon by the Examiner is Connell '124. However, Connell '124 is not directed to preparing mail. Connell is directed to scanning mail to identify the characteristics of the mail so that the Postal Office can more efficiently delegate the mail to the different postal machine based on the characteristics of the mail. See col. 2 lines 9-23. Specifically, Connell teaches to take a sample of a large batch of mail and evaluate various characteristics of the sampled pieces, such as size, print quality and reflectivity. Based on the scanned characteristics of the sampled pieces the Connell device prepares a report that can be submitted to the Post Office so that the Post Office can more efficiently process the mail. See col. 4 lines 35-48.

Connell does not teach many of the features of the claims. For instance, Connell does not teach printing anything on the mail pieces. Therefore, there is no

printer for printing the determined postage on a label as recited in claim 1. Further, since there is no printing on the pieces in Connell, Connell does not teach or suggest a labeler as recited in claim 1. Still further, Connell does not teach or suggest many of the features in the dependent claims, such as determining the postage based on the determined address and the weight of the piece. Accordingly, Applicants request that the Examiner reconsider the rejection of claims 1,2,6-8,10,11 and 13-18 over Connell in light of Sansone '864, Didriksen '055 or Thiel '214.

The second primary reference is Sansone 5,008,827. Sansone '827 is directed to a system for providing a two-way data connection between the Postal Service and the system that prepares mail. One of the primary concerns that Sansone addresses is the need to certify the operation of the system. Sansone '827 discloses a device having a scale, but there is no teaching of weighing an individual piece and determining the postage based on the weight, as recited in claim 1. Further, Sansone does not include a labeler for applying a label to the mail, as recited in claim 1.

In addition, Sansone '827 does not teach or suggest many of the features in the dependent claims. For instance, Sansone '827 does not teach or suggest determining the postage in response to the determined recipient's address and the weight of the piece, as recited in claim 2. Sansone simply determines whether the recipient's zip code is present on a piece and if so what is its readability. See col. 12 lines 39-58. Accordingly, Applicants request that the Examiner reconsider the rejection of claims 1,2, 6-8, 10, 11 and 13-18 over Sansone '827 in light of Sansone '864, Didriksen '055 or Thiel '214.

The third primary reference is Metelits '306, which is directed to a system for preparing outgoing mail. The system includes an element for inserting documents into an envelope. The envelope is conveyed to a scale to weigh the piece of mail, so that the actual weight can be compared against an estimated weight to ensure that the

proper number and type of documents were inserted into the piece of mail. More specifically, the weight is determined for an empty envelope and each of the documents to be inserted into the envelopes, and these weights are entered into the system. See col. 5 lines 17-20. Using these pre-determined weights, an estimated weight is determined for each piece based on the documents to be inserted into the envelope. See col. 5 lines 23-28. The piece of mail is later weighed and the actual weight is compared against the estimated weight. If there is a significant difference between the actual and estimated weights the mail piece is outsorted so that it can be evaluated to ensure that all of the documents were inserted into the envelope. See col. 5 lines 31-58.

Metelits '306 does not weigh the pieces and determine the postage required in response to the weight of the piece. Metelits '306 determines the postage based on an estimate of the weight. The weight is only used as an indicator of the proper insertion of documents into the mail pieces. Specifically, Metelits '306 specifically discusses the fact that postage may be wasted because the estimated weight may be higher than the actual weight. See col. 4, lines 32-36.

Since Metelits does not determine the weight of a piece and determine the postage based on the weight, Metelits does not teach or suggest claim 1. Further, Metelits does not teach or suggest an imaging station for acquiring image data to determine the address of the recipient and a labeler, as recited in claim 1.

In addition, Metelits does not teach or suggest many of the features in the dependent claims. For instance, Metelits does not teach or suggest determining the postage in response to the determined recipient's address and the weight, as recited in claim 2. Further still, Metelits does not teach or suggest comparing the recipients address and the zip code and rejecting the piece of mail if the two do not correlate. Accordingly, since Metelits does not teach or suggest the features of the claims,

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Applicants request that the Examiner reconsider the rejection of claims 1,2,6-8,10,11 and 13-18 over Metelits in light of Sansone '864, Didriksen '055 or Thiel '214.

The fourth primary reference relied upon by the Examiner is Gil '514. Gil appears to be even further distinct from the pending claims. Gil is directed to a self-service mail processing device that weighs a piece and can apply postage to the piece. However, Gil '514 does not include an imaging station for obtaining image data for the mail to determine the recipient's address. Instead, in Gil '514, the user must manually enter the recipient's address. See col. 11 lines 9-11, col. 15 lines 25-26 and col. 16 lines 20-22. Accordingly, Gil '514 does not teach or suggest claim 1 along with the features of the remaining claims.

Finally, Applicants note that the Official Action cites 9 different references in support of the various rejections. However, the Official Action never specifies which portions of the various references the Examiner is relying upon to support the different elements of the rejections. Therefore, Applicants' undersigned attorney must guess which element in each reference the Examiner is referring to in support of the rejection. This makes it extremely difficult to provide a reasoned response to the rejections. Accordingly, if the Examiner continues in his rejection of any of the claims, Applicants' attorney requests that the Examiner identify the elements in the prior art references that the Examiner believes correspond to the elements in the pending claims so that Applicants can more accurately respond to the rejection.

In light of the foregoing, Applicant believes that this application is in form for allowance. The Examiner is encouraged to contact Applicant's undersigned attorney if the Examiner believes that issues remain regarding the allowability of this application.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this Response and accompanying papers are being deposited on **January 13, 2004** with the United States Postal Service as first-class mail in an envelope properly addressed to Commissioner for Patents, Alexandria, VA 22313-1450.

__January 13, 2004__
Date of Certificate   Stephen Eland

Petition for Extension Under 37 CFR §1.136(a)

Applicant's undersigned Attorney hereby petitions for an extension of time of **TWO** months beyond the time period set in the last office communication. The proper fee is enclosed as identified in the enclosed Fee Transmittal form.

__January 13, 2004__
Date of Certificate   Stephen H. Eland
                                       PTO Registration No. 41,010